

REMARKS

This is intended as a full and complete response to the Office Action dated February 14, 2006, having a shortened statutory period for response set to expire on May 14, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claim Rejections - 35 U.S.C. § 112

Claims 1 and 10 stand rejected under 35 U.S.C. § 112, second paragraph. In response, Applicants have amended the claims to correct the antecedent basis issues identified by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim Rejections - 35 U.S.C. § 102

Claims 1-20 and 23-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Brenneke* (U.S. Patent No. 2,575,938). In response, Applicants respectfully traverse the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *Brenneke* fails to disclose each and every element of claim 1.

Claim 1 recites a method of increasing collapse resistance of a tubular that includes the act of "selecting a level of the radial force to increase collapse resistance of the tubular." However, *Brenneke* is silent with respect to collapse resistance of cylinder liners expanded with a tool disclosed therein much less any act of selecting a radial force level such that collapse resistance increases. While the Examiner cites the first claim of *Brenneke* regarding this selecting and increase in collapse resistance, the reference's claims are directed to the tool itself without any indication as to the effect it has, or is operated to have, on the cylinder liners.

Furthermore, operation of the tool disclosed in *Brenneke* does not inherently increase collapse resistance of the cylinder liner. For example, the collapse resistance of the cylinder liner may be decreased during operation of the tool such as would occur if walls of the cylinder liner are thinned by expansion to an extent that collapse resistance reduces. The cylinder liner is utilized in a cylinder for an engine or compressor such that no collapse issues regarding the liner that is in tight contact with a cylinder exist. *Brenneke* lacks any evidentiary support for teaching, showing or suggesting each and every element of claim 1. Evidentiary support must be in the record as the principal evidence upon which a rejection is based. In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir., 2001); MPEP § 2144.04.

Therefore, *Brenneke* fails to teach, show or suggest a method of increasing collapse resistance as claimed. Since each and every element of claim 1 is not disclosed in *Brenneke*, the reference cannot anticipate the claim or any claim dependent thereon. Accordingly, Applicants submit that claims 1-20 and 23-29 are allowable and respectfully request allowance thereof.

Applicants further traverse dependent claim 24, which includes the limitation of “locating the tubular in a wellbore drilled to access hydrocarbon reservoirs, wherein steps (a) to (c) are executed downhole within the wellbore.” As previously described, *Brenneke* relates to a tool for expanding cylinder liners. Therefore, *Brenneke* fails to teach, show or suggest each and every limitation of claim 24. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of this claim.

Claim Rejections - 35 U.S.C. § 103

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brenneke* (U.S. Patent No. 2,575,938) in view of *Marcovitch* (3,643,485). In response, Applicants respectfully traverse the rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See, MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there

must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. See, MPEP § 2143. The present rejection fails to establish at least the first and third criteria.

As stated above regarding the § 102 rejection of claim 1, *Brenneke* does not teach “selecting a level of the radial force to increase collapse resistance of the tubular.” Additionally, *Marcovitch* fails to overcome this deficiency in *Brenneke*. Furthermore, the Examiner states the combination of the references is obvious “in order to utilize the tool for any tubular configuration.” However, there is no indication in either reference that the tools from each reference if utilized sequentially enable applications for different tubular configurations. One can only hypothesize as to what such tubular configurations that are not supported by only one of the tools in the references would benefit from the proposed combination of tools.

Based on the foregoing, *Brenneke* in view of *Marcovitch* does not teach, show or suggest each and every element of claim 21 or claim 22 and cannot render these claims obvious. Applicants submit that claims 21 and 22 are allowable. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Conclusion

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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